

Appl. No. : 10/608,598
Filed : June 27, 2003

REMARKS

Applicant thanks Examiner Blau for the telephone interview on December 11, 2006 with Applicant's attorneys Mark R. Benedict and Agnes Juang. Claims 1-24 and 32 have been rejected, Claims 25-31 are withdrawn, and new Claims 33-35 have been added.

Applicant has added new Claim 33 to include the structural limitation that the elastomer layer further comprises a plurality of closed pores, and new Claims 34-35 to recite product-by-process limitations. As a result, Claims 1-24 and 32-35 are pending in the present application. Support for the new claims are found in the specification and claims as filed, and no new matter has been added. Reconsideration of the application in view of the foregoing amendments and following comments is respectfully requested.

Rejection of Claims 1-2, 4, 6-11, 13-16, 19, 22 and 32 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-2, 4, 6-11, 13-16, 19, 22 and 32 as obvious over Yeh in view of Yasui and Shirono. According to the Examiner, Yeh discloses a grip formed of an elongated strip comprising an elastomer layer bonded to a felt layer, but fails to teach a powdered inorganic antimicrobial agent in an elastomer. Examiner further asserted that Yasui discloses an elastomer grip formed from synthetic resin and an antibacterial and antifungal material in the form of pellets of inorganic material of silver in porous silica-alumina or zeolite carrier for sporting equipment in the form of a fishing pole. It is also the Examiner's view that since Shirono discloses an inorganic antimicrobial agent being a powder in the form of a metal being carried on zeolite as Yasui teaches, the art interchanges the terms of a pellet and a powder for an inorganic antimicrobial agent when a material is carried on a carrier.

Applicant respectfully submits that the combination of Yeh, Yasui and Shirono fails to teach Applicant's claimed invention. Yeh teaches a strip having an elastomer layer and a textile layer, that may (or may not) be made by a process similar to Applicant's method—although it is noted that Yeh suggests attaching the elastomer layer to the textile layer by stitching. Yeh fails to teach an antimicrobial agent. Yasui teaches a molded thermoplastic foam grip comprising an antimicrobial agent, wherein the antimicrobial agent is added during the manufacturing process in the form of pellets that melt into the thermoplastic before molding. Thus, Yasui fails to teach an elastomer layer bonded to a textile layer or a powdered antimicrobial agent dispersed therein. Shirono teaches antimicrobial compositions comprising colloidal solutions that may be added to

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resins, textiles, papers, paints, ceramics, etc. In the Background, Shirono teaches that powdery antimicrobial compositions are problematic—exhibiting poor dispersibility, poor antimicrobial activity, powder aggregation causing material discoloration, varying thickness in resins (paints), etc. Shirono does not provide any suggestion to a skilled practitioner to modify Yeh to add a powdery antimicrobial agent.

Applicant respectfully asserts that Shirono does not show that the pellet used in Yasui is essentially a powder. Shirono has no such teaching and to the extent that it has any relevant teaching, it is teaching away from use of antimicrobial powders. Applicant submits that the pellet in Yasui is in fact not equivalent to the powdery inorganic antimicrobial agent disclosed in Shirono or used by Applicant. According to Yasui, the “pellets” used in forming the fishing rod grip contain “about 10% by weight of an inorganic germicidal agent,” and the active ingredient of such pellet is a complex of silver and zirconium (Yasui, col. 6, lns. 20-23). Since only about 10% of the whole pellet in Yasui is the germicidal agent while the powdery composition used by Applicant (and described in Shirono) is itself the antibacterial agent, the pellet is not the same as the powdery composition. As a result, it would not have been obvious to modify the grip of Yeh using powdered inorganic antimicrobial agent.

Moreover, Shirono teaches away from using powdered antimicrobial agents with resins and rubbers. Shirono points out numerous problems associated with powdery antibacterial compositions (col. 1, lns. 16-40), and explicitly states that its objective is to provide novel antibacterial substance which can solve the problems of antibacterial powdery composition, wherein the novel antibacterial substance is in the form of a colloidal solution (col. 1, ln. 66-col. 2 ln. 3). A person skilled in the art would not have wanted to use a powdery antimicrobial agent to modify a grip of Yeh after reading Shirono. Accordingly, the use of powdered inorganic antimicrobial agent in forming the antimicrobial grip of this invention as described in Claims 1, 16, 19, 22 and 32 would not have been obvious.

Furthermore, even if assuming *arguendo* that Yeh, Yasui and Shirono are properly combinable (which they are not), the combination fails to teach or suggest all the claimed limitations in Claims 16, 19 and 22. Claims 16, 19 and 22 recite “said layers of polyurethane and felt being configured so as to reduce impact-related shock,” and none of the cited references teach or suggest such limitation. Claims 2, 4, 6-11, 13-15 directly or indirectly depend on Claim

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1 and recite unique combination of features not taught or suggested by the cited art. Applicant therefore respectfully requests the rejection of Claims 1-2, 4, 6-11, 13-16, 19, 22 and 32 be withdrawn.

Rejection of Claims 12, 17-18, 20-21 and 23-24 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 12, 17-18, 20-21 and 23-24 as obvious over Yeh in view of Yasui and Shirono, and further in view of Hayashi. Hayashi is said to disclose an inorganic antimicrobial of silver in a zeolite carrier being silver in a montmorillonite carrier. Applicant respectfully points out that Claims 12, 17-18, 20-21 and 23-24 are dependent on independent Claims 1, 16, 19 and 22, which are non-obvious over Yeh, Yasui and Shirono for all the reasons detailed above. The addition of montmorillonite cannot cure the defect in the Examiner's case of obviousness, since the combination of the references fail to render obvious a grip comprising an elastomer layer or a polyurethane layer having a powdered inorganic antimicrobial agent dispersed therein. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 12, 17-18, 20-21 and 23-24.

Rejection of Claims 3 and 5 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 3 and 5 as obvious over Yeh in view of Yasui and Shirono, and further in view of Huang. Because Claims 3 and 5 depend from independent Claim 1, which is patentable over Yeh in view of Yasui and Shirono for the reasons articulated above, the addition of Huang fails to render these claims unpatentable. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 3 and 5.

Rejoinder

Claims 25-31 were added in the Response to Office Action filed on June 27, 2005. These claims were withdrawn by the Examiner as they are directed to an invention that is independent or distinct from the invention originally claimed pursuant to 37 C.F.R. 1.142(b). Since the originally presented invention had received an Office Action on the merits, the original claims were deemed constructively elected.

According to M.P.E.P. 821.04, where product and process claims drawn to independent and distinct inventions are presented in the same application, Applicant may be called upon

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under 35 U.S.C. § 121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration under 37 C.F.R. § 1.142. However, if Applicant elects claims directed to the product and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicant requests rejoinder of Claims 25-31 in accordance with M.P.E.P. 821.04.

CONCLUSION


In view of the above remarks, Applicant respectfully requests withdrawal of rejections on the claims and assert that the present application is in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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